



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number : 10/058,175 Confirmation No.: 3199
Applicant : Joshua Gee-Yuen Mahowald et al.
Filed : January 29, 2002
Title : System and method for interactive voice services using markup
language with n-best filter element
TC/Art Unit : 2655
Examiner: : B. Albertalli

Docket No. : 53470.009005
Customer No. : 21967

Mail Stop: AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Pursuant to the Pre-Appeal Brief Conference Pilot Program announced in the Official Gazette, Applicants hereby request a pre-appeal brief conference in the above-referenced case.

This application is appropriate for a pre-appeal brief conference. A brief history of this application and why applicants believe that an appeal will succeed are set forth below. This application was filed January 29, 2002. The claims have been subject to a rejection based on a proposed combination of two references. The claims of the present application have not been amended.

As explained in the response, The Office Action fails in all of the above rejections to set forth a proper *prima facie* case of obviousness. While it recognizes that the Motorola references does not disclose or suggest a an n-best list element in an XML-based language structure as recited in the claims, the Office Action nevertheless asserts that modifying the Motorola

reference to include such a feature would have been obvious “so that a VoxML developer that wanted to verify a user’s response by presenting recognition results in an n-best list manner would easily be able to do so without having to develop their own method and corresponding VoxML code.” Such a statement represents classic impermissible hindsight.

First, the Office Action improperly *assumes* the combination recited in the claim would be desired. It says “a VoxML developer *that wanted to* verify a user’s response by presenting recognition results in an n-best list manner” (emphasis added). The PTO has the burden to establish that the prior art taken as a whole suggests the desire or advantage. Here, the PTO has boldly assumed that a VoxML developer would want to verify a user’s response using an n-best list manner. The PTO fails to explain why the art suggests that such a VoxML developer would want to use an n-best list manner. Its assumption is improper.

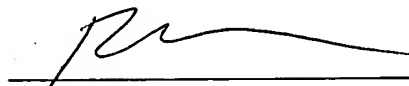
Second, the Office Action fails to provide any *evidence* (relying instead on the Examiner’s own hindsight conjecture) as to why one of ordinary skill in the art would choose to implement the n-best list element in the way claimed. None of the references the Office Action cites state that there is an advantage in adding an element in the XML-based language.

Apparently, the Office Action’s statement that it would make it easier on the VoxML developer is wholly unsupported. The Office Action’s modification of Motorola and Beith in view of Ladd suffers from similar flaws. Absent further evidence, the Office has failed to meet its *prima facie* burden. Despite the Office Action failing to provide a proper motivation contains the claims that were originally presented in the parent application that were rejected. Those claims were rejected once in the parent application and now twice in the above-referenced application based on a proposed combination of two references. To date, a *prima facie* case of obviousness has yet to be set forth. Accordingly, rather than proceeding with an expensive appeal, applicants

respectfully request that the Office either refine its position or indicate its intention to allow an appeal to proceed.

Thus, an appeal on that basis will certainly succeed, but the time and expense in preparing an appeal brief on that issue should not be borne by MicroStrategy when the grounds is so clearly improper.

Respectfully submitted,



Brian M. Buroker
Registration No. 39,125

Hunton & Williams LLP
1900 K Street, NW
Washington, D.C. 20006-1109
(202) 955-1500

Date: December 15, 2005